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09/813,949	03/22/2001	Estanislao Martinez Martinez	3582/49228	2825

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EXAMINER	
QUAN, ELIZABETH S	
ART UNIT	**PAPER NUMBER**
1743	10

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

10/CB

Office Action Summary	Application No.	Applicant(s)	
	09/813,949	MARTINEZ MARTINEZ, ESTANISLAO	
	Examiner	Art Unit	
	Elizabeth Quan	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *6* is/are allowed.

6)☒ Claim(s) *1 and 3-5* is/are rejected.

7)☒ Claim(s) [redacted] is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, such as using the term "pipe" and "suction capillary" when the specification refers to them as "tube" and "capillary suction tube", respectively. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required.

Claim Objections

2. Claim 6 is objected to because of the following informalities: It is recommended that "pyrometry" be removed from the claim since it does not appear that the device is involved in measuring temperatures. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1, 3-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Referring to claim 1, it is unclear how pyrometric describes the capsule. According to Merriam-Webster Collegiate Dictionary, pyrometric is the adjective based on pyrometer, which has a definition of an instrument for measuring temperatures especially when beyond the range of mercurial thermometers. The specification has not given a definition of the "pyrometric," and the definition of "pyrometric" given in the dictionary does not make sense with the disclosed invention, which deals with collecting soil samples for extraction. The capsule of the device

does not measure temperatures. Applicant is advised to provide a reference with an intelligible definition of "pyrometric."

6. Referring to claim 1, it appears from the amended drawings that the device (1) is a probe (2) comprising of a rubber cap (6) with holes (7) and (8) through which an adapter tube (9) that is connected to a vacuum pump (not shown) and capillary suction tube (10) are respectively fitted through, pipe which is really tube (5) as designated by the specification, and capsule (3) with a decreased section (4). Applicant is not using consistent language in which "pipe" in the claim 1 and "tube (5)" in the specification. However, confusion would arise from the various tubes--adapter tube (9) and capillary suction tube (10)--if the "pipe" in claim 1 were amended to "tube" according to the specification. It is suggested that "tube (5)" in the specification be replaced with "pipe (5)."

7. Claims 3-5 provide for the use of the device for agricultural, environmental, and industrial applications, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 3-5 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,043,133 to Richards in view of U.S. Patent No. 4,692,287 to Timmons, and further in view of U.S. Patent No. 3,871,211 to Tal.

Richards disclose a device for extraction of samples of an aqueous solution in a comprises a probe including a pipe (8) of inert material, capsule of porous ceramic with a first end of lesser diameter than a second end to which is attachable the pipe of inert material, and cap sealing the pipe (fig. 1).

Richards disclose a cap with a hole in which an adapter tube is connectable to a vacuum pump (fig. 1; col. 2, lines 28-63). Richards fail to disclose the cap with at least two holes in which an adapter tube connectable to a vacuum pump is fitted into one of the holes and suction capillary that can be placed inside the probe is fitted into a different hole. Timmons disclose a

cap with two holes in which an adapter tube (22), which connects with a vacuum pump, is fitted into one of the holes to draw soil water samples and suction capillary (23), which extends from within the probe upwardly to a container at the ground surface for collecting the soil water sample, is fitted into a different hole. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Richards to include a second hole through which a suction capillary tube may fit to conveniently collect soil water sample to container at ground surface level as taught by Timmons (col. 3, line 61-col. 4, line 7).

Richards fail to explicitly disclose that the capsule is made from porcelain. According to Merriam-Webster Collegiate Dictionary, porcelain is defined as a hard, fine-grained, sonorous, nonporous, and usually translucent and white ceramic ware that consists essentially of kaolin, quartz, and feldspar and is fired at high temperatures, and ceramic is defined as of or relating to the manufacture of an product (as earthenware, porcelain, or brick) made essentially from a nonmetallic mineral (as clay) by firing at a high temperature. Therefore, porcelain is made from ceramic, and ceramic may be porcelain. Since porcelain and ceramics are related materials in that ceramics is the genus and porcelain is a species of ceramics, they are recognized equivalents in materials. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use specifically porcelain within the broad group of ceramics in the capsule disclosed by Richards because of their being recognized functional equivalents.

Richard fails to disclose that the cap is made of rubber. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a rubber

cap since it is well known that a rubber cap effective seals a container during and after its penetration as demonstrated by Tal (col. 2, lines 22-35).

Note: The device may be used for the purposes recited in claims 3-5.

Allowable Subject Matter

11. Claim 6 is allowed.

Response to Arguments

12. Applicant's arguments with respect to claims 1 and 3-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan
Examiner
Art Unit 1743

eq

Jill Warden
Supervisory Patent Examiner
Technology Center 1700